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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,301	12/19/2001	Maurice R. De Billot	17396/09015	8087

45850 7590 04/15/2009
NELSON MULLINS RILEY & SCARBOROUGH, LLP
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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04/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/026,301	Applicant(s) DE BILLOT ET AL.	
	Examiner ALTON N. PRYOR	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments filed 1/21/09 have been fully considered but they are not persuasive. See argument below. Previous rejections not addressed below have been withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). "

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 111-113, 115-117 and 122-125 of copending Application No. 11/138,965 as published in U.S. Patent Application Publication No. 2005/0233905. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims both recite increasing the vigor and/or yield

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of a plant that has had a transgenic event by applying an herbicide and a fungicide, where the set of fungicide compounds as claimed in the instant application overlaps with those recited in the conflicting published application. Accordingly, it is considered that the overlapping fungicide compounds render the instant claims obvious over the methods recited in the conflicting application. Accordingly, claims 103-104, 106, 108-110, 112, 117, 134-148, 150, and 153-158 are not patentably distinct over claims 111-113, 115-117 and 122-125 of copending Application No. 11/138,965.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

With respect to the double patenting rejection of claims 103,106,108,109,112, 117,135,138,140,142,143,153 and 155-158 over U.S. Patent Application Publication No. 2005/0233905 will be maintained until all other rejections on record are overcome.

Claims 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3-8,31-34,65,69--77 of copending Application No. 10/832,578. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims both recite increasing the vigor (health) and/or yield of a plant that has had a transgenic event by applying an herbicide and a fungicide, where the fungicide compound is silthiopham as claimed in the instant application. The claims in the instant application differ from those recited in USAN '578 in that the claim in USAN '578 is drawn specifically to using silthiopham as the fungicide

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rather than to an instantly claimed group of compounds set forth by a formula which includes silthiopham. Because USAN '578 makes claim to a specific species, silthiopham, embraced by the formula in the instant application. USAN '578 renders the instant method of using silthiopham obvious.

Claims 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,7,8,26,29-34,54,65,68-75 of copending Application No. 12/011424. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims both recite increasing the vigor (health) and/or yield of a plant that has had a transgenic event by applying an herbicide and a fungicide, where the set of fungicide compounds as claimed in the instant application overlaps with those recited in USAN '424. Accordingly, it is considered that the overlapping fungicide compounds render the instant claims obvious over the methods recited in the conflicting application. Accordingly, claims 103-104, 106, 108- 110, 112, 117, 134-148, 150, and 153-158 are not patentably distinct over claims 1,7,8,26,29-34,54,65,68-75 of copending Application No. 12/011424.

The above are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claims 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 are rejected on the ground of nonstatutory obviousness-type double patenting as being

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unpatentable over claims 1-82 of U.S. Patent No. 7098170. Although the conflicting claims are not identical, they are not patentably distinct from each other because both USPN '170 and instant invention makes to claim to a method of applying to instant plants / crops the instant thiophene compounds in order to control disease. The USPN '170 makes claim that the disease controlled is caused by Gaeumannomyces sp., whereas instant claims are to the control of an agronomic plant that is not affected by Take-all disease. The control of Gaeumannomyces sp. makes the Take-all disease obvious since the control of Gaeumannomyces sp. is directed related to Take-all disease.

Response to Applicants' Argument

Applicants argue that USPN 7098170 teach the use of silthiofam in combination with fungicides and does not suggest the use of silthiofam alone to increase the yield and vigor of beans. The Examiner argues USPN '170 makes claim to increasing the vigor and/or yield of an agronomic plant such as a soybean (legume) plant comprising treating the plant or propagation material thereof with fungicides. See USPN '170 claims 1,16,23,41. USPN '170 further claims that the plant or propagation material can be treated with silthiofam (USPN '170 claims 5,41). USPN '170 claims 33 and 71 makes claim to the propagation material possessing a transgenic event which provides the plant with resistance to a herbicide such as glyphosate. In addition instant claims employ comprising language with allows for the inclusion of other ingredients such as the fungicides disclosed in USPN '170. There appears to be no response provided by the Applicants to this rejection.

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 103,106,108,109,112,117,135,138,140,142,143,153 and 155-158 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase recited in claim 103 involving beans selected from the genera *Vigna*, *Glycine*, *Vicia* and *Phaseolus* not being affected by Take-all disease is new matter. The specification discloses that soybean is not affected by Take-all disease (instant specification page 2 lines 26-28). No other bean type or bean genus is mentioned as not being affected by Take-all disease. Therefore it is new matter to claim that beans selected from the genera *Vigna*, *Glycine*, *Vicia* and *Phaseolus* as not being affected by Take-all disease.

Response to Applicants' argument

The Applicants argue that the phrase, beans selected from the genera *Vigna*, *Glycine*, *Vicia* and *Phaseolus* not being affected by Take-all disease, recited in claim 103 is not new matter. The Applicants direct the Examiner's attention to pages 9-10 and original claim 20 to support that the phrase is not new matter. The pages 9-10 and original claim 20 supports the inclusion of each genera (*Vigna*, *Glycine*, *Vicia* and

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Phaseolus) literally added to the claim by the Applicants since the specification states that soybeans are not affected by Take-all disease. Applicants also provide information sheets from the University of Missouri, Oregon State University, and Australia' CSIRO Land and Water to support that legumes are not susceptible to Take-all disease. Applicants further state that all the genera literally added to the claim are beans in the sub-family Faboideae and thus, share significant metabolic pathways. Applicants argue that because soybeans are not affected by Take all disease, the members of these genera would also not be affected by the disease. The Examiner maintains that the addition of the phrase, genera Vigna Glycine, Vicia and Phaseolus not being affected by Take-all disease, is new matter. It is improper to state that a single species (soybean) in a genus would render obvious all related genera (Vigna Glycine, Vicia and Phaseolus) obvious.

Other Matters

The Examiner agrees that Sander's declaration filed 2/5/07 is proper and that the declaration has been considered in the prosecution of this application.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616